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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/728,558      | 12/05/2003  | Daniel James Dickinson | AN15D1              | 9984             |

7590 05/04/2004

EUSTATHIOS VASSILIOU  
TERMAX CORPORATION  
920 Remington St.  
Schaumburg, IL 60173

| EXAMINER |
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SALDANO, LISA M

| ART UNIT | PAPER NUMBER |
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3673

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                  |  |
|------------------------------|-----------------|------------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)     |  |
|                              | 10/728,558      | DICKINSON ET AL. |  |
|                              | Examiner        | Art Unit         |  |
|                              | Lisa M. Saldano | 3673             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/5/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 13-18, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-18, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/5/2003</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not make reference to the application reference number of the present invention.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 3, which is listed after claim 25, been renumbered as claim 26. The application as presented by the applicant contained an originally submitted claim numbered 3 and a newly submitted claim numbered 3.

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### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6, 13-18, 25 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,726,418. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,726,418 claims a spring fastener with a head portion and an elastic body. U.S. Patent No. 6,726,418 claims that the elastic body has at least one front portion and at least one back portion, as well as side portions with front and back snapping segments. U.S. Patent No. 6,726,418 recites all the limitations claimed by the applicant in the present invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 13-15, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell et al (5,774,949) in view of Smith (5,725,343).

Regarding claim 1, Cornell et al disclose a trim clip 100 comprising a head portion 8 having an upper side with an engagable hole 22 for a securing member 26 (see Fig.1). The head portion 8 also has a lower side (see Fig.1). The trim clip also comprises a body portion extending from the lower side of the head portion extending at a substantially right angle with respect to the head portion. The body portion comprises a front body portion and back body portion made of arms 12, 12' and bridging portions 20, 20'. The front and back body portions also have openings or windows 17, 17' that have opening tops, opening bottoms and opening sides. The windows 17, 17' each have a side body portion 10, 10' on each opening side (see Fig.2). Cornell et al also disclose front and back snapping segments made along arms 12, 12' connected to the front and back body portions in the vicinity of the opening bottom wherein the snapping segments

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comprise a free engagement end 15,15'. The front snapping segments are disposed along the front opening.

Regarding claims 2 and 14, Cornell et al disclose the trim clip as disclosed above, wherein the trim clip comprises a secondary engagement section comprising spaced-apart prongs 16,16'.

Regarding claims 3, 15, 25 and 26, Cornell et al disclose the trim clip as disclosed above wherein the side body portions comprise an inner surface that is capable of functioning as a tertiary segment.

Regarding claim 13, Cornell et al disclose the trim clip as disclosed above wherein the clip is used on an automobile body (see column 1, lines 5-10) to connect trim 24 and resilient foam material 28 to the frame of the automobile or vehicle.

However, Cornell et al fail to disclose an elastic body disposed at least under the lower side of the head portion. Please note, however, that Cornell et al do disclose resilient foam material 28 included in the assembly of trim 24 onto frame (see Fig.5 and column 3, lines 16-21). Cornell et al disclose that the inclusion of the foam assists in preventing loosening of the assembly.

Smith discloses a sealing fastener for connecting a first object 11 to a second object 13. The sealing fastener includes an elastic body 7 that is compressed during installation of the fastener. Smith discloses that, once completely installed, the elastic body provides sealing from water leakage as well as reduction in squeaking noises due to vibrations.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the elastic body under the head of the clip of Cornell et al, as taught by Smith, because

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the elastic body compresses and reduces the effects of vibrations in the assembly, which ultimately lead to loosening of the assembly. Cornell et al provide this effect by putting an elastic body (foam 28) over the head of the clip. Smith achieves the same effect by providing an elastic body under the head of the clip.

7. Claims 4-6 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell et al in view of Smith as applied to claims 1-3 and 13-15 above in view of either Kuffel (5,759,004) OR Fischer (5,919,019).

Regarding claims 4-6 and 16-18, Cornell et al and Smith disclose the trim clip and sealing fasteners, respectively, as described above. Specifically, Cornell et al disclose front and back snapping segments made along arms 12,12' connected to the front and back body portions in the vicinity of the opening bottom wherein the snapping segments comprise a free engagement end 15,15'.

However, neither Cornell et al nor Smith explicitly disclose the use of anti-sliding sections or anti-opening sections on the free engagement ends of the snapping segments.

Kuffel discloses a push mount 10 for connecting a cable tie strap 26 to a mounting surface 30. The push mount comprises centering tabs 22 and reversely bent portions 20 or legs 18 that abut the underside of mounting surface 30 to retain the mount 10 in engagement with the mounting surface thereby providing an anti-opening section of the free engagement ends of the leg 18 (see column 2, lines 38-43).

Fischer discloses a mid-panel nut 10 securing a panel 14 to another apparatus 28. The nut comprises two extensions 40 with panel edge securing means 48, wherein the tip 50, 58 of the means 48 is provided with a good frictional surface such as with knurled or scored sections (see

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Figs. 2&5 and column 2, lines 47-50 and column 3, lines 43-48). Fischer discloses that the scored regions secure the nut 10 against lateral movement within a panel opening 18.


It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the anti-opening and/or anti-sliding portions taught by either Kuffel or Fischer on the trim clip of Cornell et al because the anti-opening and/or anti-sliding portions provide a means to further secure the clip in the opening of the panel thereby further securing the entire fastening arrangement, which serves the basic purpose of fastening elements that are intended to keep two objects connected to one another.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa M. Saldano whose telephone number is 703-605-1167. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on 703-308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
TERI PHAM LUU  
PRIMARY EXAMINER